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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,232	09/28/2001	William J. Jones	247171-000305USP1	1787

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EXAMINER

SHAPIRO, JEFFERY A

ART UNIT	PAPER NUMBER
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3653

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01/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/967,232	Applicant(s) JONES ET AL.	
	Examiner JEFFREY A. SHAPIRO	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 11-89 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87 and 89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/29/07 & 10/31/07</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 13,14,16,21,30-32,34,37,41-48,57,58,60-64,66,67,71-78,81-86 and 88.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/07 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 1, 5, 6, 11, 15, 17-20, 22-24, 33-36, 38-40, 49, 56, 59, 65, 68-70, 79, 80, 87 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munro et al (US 5,790,697) in view of Bittner et al (US 5,290,033).

Regarding Claims 1, 11, 38-40, 56, 79, 87 and 89, Munro discloses a document processing apparatus (10) that processes stacks of currency placed in an input receptacle (12) in mixed denominations through a transportation mechanism (16) past a discriminating/evaluating unit (18a, b) to one or more output receptacles (20). See Abstract and figure 2a of Munro. Munro also discloses a controller (30) with a memory (34). Munro also discloses sending flagged unacceptable bills to a particular output receptacle while also sending acceptable bills to another output receptacle. See col. 93, line 10-col. 94, line 24.

Regarding Claim 80, Munro discloses stranger bills, no call bills, suspect bills, flagged bills and authentic bills.

Regarding Claims 5, 6, 23 and 24, Munro discloses operating said apparatus at a range of speeds at col. 43, lines 10-15 and 62-67.

Regarding Claims 15, 17-20, 22, 65, 68-70, note that Munro illustrates a display/interface in which a user can program the apparatus. See Munro, figures 62-64.

Regarding Claims 1, 11, 33-36, 49, 56, 59, 79, 87 and 89, Munro does not expressly disclose, but Bittner discloses an evaluation unit (226) having both a validator/discriminator and a barcode reader (222), for the purpose of processing both barcoded documents as well as paper currency.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated a barcode reader in Munro's evaluation device for the purpose of handling barcoded documents placed in the same stack of documents as paper currency.

Regarding Claims 35 and 36, official notice is taken that it is obvious to use a mirror to direct light beam to therefore direct them toward a detector/reader.

5. Claims 2-4 and 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munro et al (US 5,790,697) in view of Bittner et al (US 290,033) and further in view of Izawa et al (US 6,264,556 B1).

Regarding Claims 2-4 and 51-54, Munro discloses the document processing apparatus (10) as described above.

Munro does not expressly disclose, but Izawa discloses use of coded coupons, scrip or secured paper, which is considered to be paper tokens and substitute funds.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have processed various types of substitute funds such as casino scrip, coupons, gift certificates, and paper tokens or any other type of secure document typically used in commerce in Munro's apparatus, as taught and suggested by Izawa since Munro's device is intended to process secure documents typically used in commerce.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munro et al (US 5,790,697) in view of Bittner et al (US 290,033) and further in view of Molbak (US 5,620,079).

Regarding Claim 12, Munro discloses the document processing apparatus (10) as described above.

Munro does not expressly disclose, but Molbak discloses incorporation of a communication port (1826, 1828), as illustrated in figures 18a and b.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated a communication port in the form of a modem, as taught by Molbak, in Munro's apparatus, for the purpose of transferring data. See Molbak at col. 11, line 62-col. 12, line 29.

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munro et al (US 5,790,697) in view of Bittner et al (US 290,033) and further in view of Ueshin (US 4,690,268).

Regarding Claim 25, Munro discloses the document processing apparatus (10) as described above.

Munro does not expressly disclose, but Ueshin discloses incorporation of a facing mechanism (20), as illustrated in figures 2-7.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated a facing unit, as taught by Ueshin, in Munro's apparatus, for the purpose of reversing a banknote.

8. Claims 26-29, 50, 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munro et al (US 5,790,697) in view of Bittner et al (US 290,033), further in view of Ahlquist et al (US 6,112,982), further in view of Yamashita (US 5,293,033), further in

view of Storch (), further in view of Roustaei (5,777,314) and still further in view of Walker et al (US 6,754,636).

Regarding Claims 26-29, 50 and 55, Munro discloses the document processing apparatus (10) as described above.

Munro does not expressly disclose, but Ahlquist discloses incorporation of multiple barcode readers (80, 82 and 84), as illustrated in figure 3 and discussed at col. 3, lines 20-30, for the purpose of creating redundancy so as to ensure that barcodes transported along a transport mechanism are read.

Munro does not expressly disclose, but Yamashita discloses using multiple barcode readers, as illustrated in figures 1 and 2 for the purpose of ensuring the reading of barcodes located on various sides of a transport path through which the barcodes are transported. See Yamashita, abstract.

Munro does not expressly disclose, but Walker discloses at col. 36, lines 45-57, that vouchers may exhibit several barcodes on them.

Munro does not expressly disclose, but Storch discloses use of barcodes on currency. See figure 28 of Storch, which illustrates an upper and lower barcode with a reader placed to read the upper barcode.

Munro does not expressly disclose, but Roustaei discloses use of different types of barcodes, such as one, two and three-dimensional barcodes and using various readers for reading such barcodes. See abstract and col. 10, lines 7-42 of Roustaei.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated more than one barcode of various types for the purpose of

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imparting various information in a secure fashion on a secure document. See again Walker and Storch.

Additionally, it would have been obvious to one of ordinary skill in the art to have placed more than one barcode reader at any orientation necessary along the transport path of bills since one ordinarily skilled would have found it logical to do so for the purpose of redundancy as well as to obtain various barcodes located in different areas of a voucher or a currency bill. See again, Yamashita and Ahlmquist.

Further, it would also have been obvious to use various types of barcodes, i.e., symbology, such as one or two dimensional barcodes, which are read by different readers, for the purpose of imparting different information. See again, Roustaie.

Further regarding Claim 55, note that it would have been obvious as a matter of design choice to have made the barcoded media the same size as US currency bills, for the purpose of ensuring that the document processor can handle both bills and the media through the same transport mechanism.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87 and 89 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-73 of U.S. Patent No. 6,880,692; Claims 1-78 of U.S. Patent No. 6,913,130; Claims 1-91 of U.S. Patent No. 6,959,800; Claims 1-31 of U.S. Patent No. 6,955,253 or Claims 1-26 of U.S. Patent No. 6,868,954 in view of Bittner et al (US 5,290,033). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to the following.

A system and apparatus for discriminating and counting currency bills including receiving a stack of bills, transporting the bills, counting and determining the denominations of the bills utilizing a detector, determining whether the bills fail or meet certain criteria, halting the transporting when a failing bill is identified, and placing the failed bill as the last bill in one of the output receptacles.

Although not all of the claims may have recited a "barcode reader" that reads substitute currency, it is considered to be obvious to have included such a device in light of the teaching of Bittner. As described above, Bittner discloses an evaluation unit (226) having both a validator/discriminator and a barcode reader (222), for the purpose of processing both barcoded documents as well as paper currency.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated a barcode reader in the currency processing devices of

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the '692, '130, '800, '253 and '954 patents for the purpose of handling barcoded documents placed in the same stack of documents as paper currency.

11. Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87 and 89 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1, 5, 13, 25, 26, 37 and 49 of U.S. Patent No. 7,103,438; Claims 1 and 6 of U.S. Patent No. 7,201,320; Claims 1-69 of U.S. Patent No. 6,843,418; Claims 1-24 of U.S. Patent No. 7,146,245 or Claims 14, 19, 20, 31 and 41-47 of U.S. Patent No. 7,016,767. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to the following.

A system and apparatus for discriminating and counting currency bills including receiving a stack of bills, transporting the bills, counting and determining the denominations of the bills utilizing a detector, determining whether the bills fail or meet certain criteria, halting the transporting when a failing bill is identified, and placing the failed bill as the last bill in one of the output receptacles, and a "barcode reader" that reads substitute currency.

12. Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87 and 89 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 7-29, 78-89 and 146-149 of copending Application No. 09/684,103 view of in view of Bittner et al

(US 5,290,033). Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed toward the following.

a method and apparatus for discriminating and counting currency bills including receiving a stack of bills, transporting the bills, counting and determining the denominations of the bills utilizing a detector, determining whether the bills fail or meet certain criteria, halting the transporting when a failing bill is identified, and placing the failed bill as the last bill in one of the output receptacles.

Although not all of the claims may have recited a "barcode reader" that reads substitute currency, it is considered to be obvious to have included such a device in light of the teaching of Bittner. As described above, Bittner discloses an evaluation unit (226) having both a validator/discriminator and a barcode reader (222), for the purpose of processing both barcoded documents as well as paper currency.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated a barcode reader in the currency processing device of the '103 application for the purpose of handling barcoded documents placed in the same stack of documents as paper currency.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

13. Applicant's arguments with respect to Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87 and 89 have been considered but are moot in view of the new ground(s) of rejection.

Regarding submission of any future terminal disclaimers in this case, it is suggested that Applicants' representative ensures that the record properly reflects authorization to sign for said applicants in order to avoid refusal of entry of an otherwise perfectly acceptable terminal disclaimer, as had been the case in the prior submission.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Burns et al, (US 2002/0034977 A1) and (US 6,048,269) are cited as disclosing another system which uses a barcode reader in conjunction with a paper currency discriminator in a document evaluator.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY A. SHAPIRO whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey A. Shapiro
Examiner
Art Unit 3653

January 22, 2008